IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 339

ROBERT A. FISCHER, THE FISCHER CORPORATION and A. S. ALOE COMPANY.
Petitioners,

vs.

F. H. BOWERS and LOUIS J. BRISTOW,
Respondents.

Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit and Brief in Support Thereof.

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Respondents.

Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

To the Honorable, the Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Robert A. Fischer, The Fischer Corporation and A. S. Aloe Company, pray that a writ of certiorari issue to review a judgment of the United States Circuit Court of Appeals for the Ninth Circuit, filed April 21, 1945, as amended by order of June 1, 1945, reversing the judgment of the United States District Court for the Southern District of California, Central Division, as to petitioners. A memorandum opinion of the District Court and the summary judgment rendered appear on pages 109 to 113 of the transcript of record furnished herewith. The

opinion of the Circuit Court of Appeals was withdrawn after petition for rehearing and the amended opinion and decree appear at pages 145 to 156 of the transcript of record.

Jurisdiction.

The jurisdiction of this Court is invoked under §240(a) of the Judicial Code, 28 U. S. C. §347(a) as amended. There have been no concurrent findings by Courts below (*Altoona Publix Theatres, Inc., v. American Tri-Ergon Corp., et al.,* 294 U. S. 477).

Short Statement of the Case.

An action for infringement of United States Letters Patent No. 2,123,709 was brought against the petitioners on October 26, 1942 in the United States District Court for the Southern District of California, Central Division. Petitioners filed a timely answer and two sets of requests for admissions under Rule 36, F. R. C. P. Plaintiffs below did not file answers to these requests. It is established by the authorities that facts requested are admitted unless denied.

Petitioners moved for summary judgment [Tr. 79-94] and after hearing, the trial Court was satisfied that there was no genuine issue as to any material fact and granted the motion for summary judgment.

The Circuit Court of Appeals reversed the judgment of the trial Court on the ground that findings of fact and conclusions of law are required by Rule 52(a) even though a summary judgment was granted under the provisions of Rule 56(b) and (c). The Circuit Court of Appeals further held that the trial Court erred in striking

answers to requests (filed late and without leave of Court), that the affidavits filed were in opposition, that there was an issue as to material facts, and hence a summary judgment was not proper.

Questions Presented.

1. Does Rule 52(a) of Federal Rules of Civil Procedure require findings of fact and conclusions of law where the action is determined by the granting of a motion for summary judgment?

2. Does Rule 42(b) and (c) of Federal Rules of Civil Procedure require findings of fact and conclusions of law to be lodged when a motion for summary judgment is granted?

3. Does a trial Court abuse its discretion in striking affidavits and answers to a request for admissions

(a)—which do not conform to the requirements of Rule 56(e),

(b)—which are filed after the day of hearing on a motion for summary judgment and in violation of the requirements of Rule 56(c)?

Reasons for Granting the Writ.

1. The Circuit Court of Appeals has decided a question of practice and procedure under the Federal Rules of Civil Procedure which question has not been, but should be, settled by this Court, or has decided such question in a way probably not in accord with this Court's intended construction of Rules of Civil Procedure.

The Supreme Court of the United States has the power to prescribe general rules for the practice and procedure in the District Courts of the United States (Act of June

19, 1934, c. 651 §1) and has done so. It is submitted that this Court should decide the applicability and scope of the rules since the decision of the Circuit Court of Appeals renders impotent Rules 56(b) and (c).

In the instant case the Circuit Court of Appeals holds that the filing of an answer raises issues, that the presentation of affidavits as contemplated by Rule 56(c) also raises issues as to material facts and appears to deprive the trial Court of authority to render a summary judgment.

A defendant in a patent case should not be forced into a protracted trial for alleged patent infringement and deprived of the right, given by the Federal Rules of Civil Procedure, of obtaining a summary judgment in his favor, when, as here, the admissions and exhibits before the trial Court permit the trial Court to dispose of the matter on questions of law alone.

2. The decision of the Circuit Court of Appeals is of great public importance inasmuch as it places obstacles in the way of all defendants entitled to a summary judgment. Litigation in other circuits on the patent in suit herein is improbable. The issue is much wider in scope than the patent in suit and affects the application and enforcement of the Federal Rules of Civil Procedure in all cases brought in the Federal Courts.

3. The Circuit Court of Appeals has departed from the accepted and usual course of judicial procedure and interpretation of Rules 42(b) and (c), 52(a) and 56(c) and (e), and such departure calls for the exercise of this Court's power of supervision.

Since the Federal Rules of Civil Procedure have been prescribed by this Court, it is submitted that this Court should exercise supervision of the administration and interpretation of such rules.

4. The Circuit Court of Appeals has decided an important question of administrative law in a way which is probably untenable and in conflict with the weight of authority.

All of the Federal Courts are interested in accurately interpreting and administering the Federal Rules of Civil Procedure. There is conflict as to the applicability of Rule 52(a) to summary judgments granted under Rule 56(b). Rule 56(b) is an important rule designed to attain the "* * * just, speedy and inexpensive determination of every action" contemplated by Rule 1. By emasculating these rules, procedure becomes complex and not simplified.

5. The decision of the Circuit Court of Appeals is in conflict with decisions of the Circuit Courts of Appeals in other circuits and with the decisions rendered by the United States Court of Appeals for the District of Columbia relating to the interpretation and administration of the same rules.

The decision is in direct conflict with *Thomas, et al., v. Peyser, et al., United States Court of Appeals, District of Columbia*, 118 F. (2d) 369, where it was specifically held that:

> "There is no merit in appellants' contention that the trial Court should have made findings of fact."

The decision is in conflict with other cases cited in the appended brief under the heading "Specification of Errors."

6. The Circuit Court of Appeals departed from precedent and weight of authority in stating that the trial Court abused its discretion in striking from the record answers which were filed without leave of Court and in violation of the specific provisions of Rule 56(c).

The weight of authority states that a judgment should stand if the opinion gives the appellate Court a clear understanding of the basis of the decision. The authorities uniformly hold that unless the decision of the trial Court was clearly erroneous, its judgment should not be disturbed. No such error appears in the record.

Prayer.

Petitioners pray that a writ of certiorari issue to review the judgment and decree of the United States Circuit Court of Appeals for the Ninth Circuit, that said judgment be reversed, and that this Court decide the questions of practice and applicability of the Federal Rules of Civil Procedure presented by this petition.

Respectfully submitted,

CASIMIR A. MIKETTA,

Attorney for Petitioners.

State of California, County of Los Angeles—ss.

Casimir A. Miketta, being first duly sworn, deposes and says, that he is the attorney for the petitioners named in the foregoing Petition for Writ of Certiorari; that he has read the foregoing Petition for Writ of Certiorari and knows the contents thereof; and that the same is true of his own knowledge except as to the matters which are therein stated upon his information or belief, and as to those matters, that he believes them to be true.

CASIMIR A. MIKETTA.

Subscribed and sworn to before me this 8th day of August, 1945.

MYRTLE JOHNSON,

Notary Public in and for the County of Los Angeles, State of California.

My commission expires April 17, 1949.

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vs.

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Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinion and Judgment of Courts Below.

The motion for summary judgment was based upon the admissions resulting from the failure to deny the requests for admissions and upon the affidavits and exhibits of prior patents presented with the motion. The trial Court granted the motion [Tr. 109-110] on the authority of *Smyth v. Kaufman, et al.*, 114 F. (2d) 40 (C. C. A. 2), and many other cases, stating in its decisions:

> "On the whole I am satisfied, under the pleadings, affidavits and admissions, that there is no genuine issue as to any material fact. (Rule 56(c), Federal Rules of Civil Procedure)."

The trial Court ordered stricken from the files those answers to requests for admissions, which answers were filed after the hearing on the motion and without leave of Court, stating that they did not comply with Rule 56(e), Federal Rules of Civil Procedure.

The summary final judgment [Tr. 111-113] recites that the Court considered the pleadings, the requests for admissions,

> "* * * the admissions resulting from the failure of plaintiffs to serve upon defendants a sworn statement denying the matters on which admissions were requested",

the affidavits, and exhibits of prior patents, and continues by holding—

> "The Court having found that there is no genuine issue as to any material fact to be submitted to the trial Court",

whereupon the trial Court held that the patent was invalid and dismissed the complaint with costs. This judgment was dated June 8, 1943.

A timely appeal was filed by plaintiffs below and the Circuit Court of Appeals for the Ninth Circuit rendered an opinion on April 21, 1945. A petition for rehearing was filed and the original opinion was withdrawn and amended by order of June 1, 1945. The amended opinion appears on pages 145 to 154 of the transcript. Only such portions of the opinion as pertain to petitioners Fischer et al., [Tr. 149-154] are under consideration here. The decree of the Circuit Court of Appeals appears on pages 155-156 of the transcript.

Jurisdiction.

The jurisdiction of this Court is invoked under §240(a) of the Judicial Code as amended. The action in this case was a suit under the patent laws, §24(7) of the Judicial Code. The effective date of the judgment and decree of the Circuit Court of Appeals, to which this petition for writ of certiorari is directed, is June 1, 1945.

Statement of the Case.

The facts leading up to the presentation of this petition are stated in the petition and in the first section of this brief.

Specification of Errors.

1. The Circuit Court of Appeals erred in holding that whenever issues are drawn by the pleadings, findings of fact and conclusions of law are required under Rule 52 of the Federal Rules of Civil Procedure.

Issues are drawn whenever an answer is filed. A case may be terminated without trial by reason of default, dismissal, or summary judgment. Findings of fact and conclusions of law are not required under such circumstances. The decision of the Circuit Court of Appeals for the Ninth Circuit is in conflict with the decisions in many other circuits.

Bushwick-Decatur Motors, Inc. v. Ford Motor Co., (C. C. A. 2) 116 F. (2d) 675;

Thomas, et al., v. Peyser, et al., (U. S. Ct. App. D. C.) 118 F. (2d) 369, 374;

Milcor Steel Co. v. George A. Fuller Co., et al., (C. C. A. 2) 122 F. (2d) 292 (affirmed 316 U. S. 143);

Farley v. Abbetmeier, et al., (U. S. Ct. App. D. C.) 114 F. (2d) 569;

Lucking v. Delano, (U. S. Ct. App. D. C.) 122 F. (2d) 21, 22;

Somers Coal Co. v. United States, (U. S. D. C. Ohio) 6 F. R. S. 546;

Prudential Insurance Co. of America v. Goldstein, 43 Fed. Supp. 767.

The decision rendered in the instant case by the Circuit Court of Appeals is in actual conflict with the decision of the same Court in *Piantadosi v. Loew's Inc.,* 137 F. (2d) 534, since in that case a summary judgment was granted by the trial Court, no findings were lodged, and the summary judgment was affirmed.

2. The Circuit Court of Appeals erred in disregarding—

> "* * * the admissions resulting from the failure of plaintiffs to serve upon defendants a sworn statement denying that matters on which admissions were requested" (quoted language from summary judgment of trial Court).

Rule 36(a) and (b) specifies the manner in which requests for admissions may be answered and used. It has been repeatedly held that failure to deny a request (as in this case) constitutes an admission.

Smyth v. Kaufman, et al., 114 F. (2d) 40 (C. C. A. 2);

Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., (C. C. A. 7) 131 F. (2d) 809;

Walsh v. Connecticut Mutual Life Insurance Co. of Hartford, Conn., 26 Fed. Supp. 566;

Merriman v. Broderick, 38 Fed. Supp. 13.

3. The Circuit Court of Appeals erred in reversing the judgment of the trial Court without considering the showings of the prior patents which were before the trial Court and to which many of the requests for admissions were directed. The judgment of the trial Court stated that "* * * exhibits of prior patents filed with the motion for summary judgment" were considered.

The trial Court had an opportunity of hearing arguments, had observed the conduct of the parties, and had considered all of the facts presented. The judgment of the trial Court should not be disturbed unless the decision of the trial Court is clearly erroneous. No such error appears here.

United States v. McGowan, et al., (C. C. A. 9) 62 F. (2d) 955, 957, (affirmed 290 U. S. 592).

4. The Circuit Court of Appeals erred in holding that there is no warrant for a summary judgment within Rule 56(b) and (c) of the Federal Rules of Civil Procedure where

(a)—issues are drawn by the pleadings, and

(b)—affidavits in opposition have been filed.

This ruling effectively emasculates Rule 56 and in effect deprives litigants of the salutary provisions of this rule. That the Circuit Court of Appeals is in error is evident from the fact that Rule 56(c) provides for opposing affidavits and states:

> "The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that, except as to the amount of damages, there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law."

The trial Court found that there was no genuine issue as to any material fact. The only affidavit in opposition was filed without leave of Court, after hearing on the motion, and flagrantly violated the requirements of Rule 56(e). The trial Court had the right to disregard this opposing affidavit for reasons stated in Rule 56(e).

The rule which permits parties to terminate litigation by motion for summary judgment should not be emasculated. As stated by Circuit Judge Clark (C. C. A. 2):

> "In my judgment, the summary judgment will lose much of its usefulness, will be in effect little more than the old demurrer, if a 'genuine issue' is discoverable when, as here, the full and complete affidavits of the parties show no basis upon which a plaintiff's verdict could be sustained." (Bushwick-Decatur Motors, Inc. v. Ford Motor Co., 116 F. (2d) 675, 679.)

5. The Circuit Court of Appeals erred in stating that—

> "* * * it was an abuse of the Court's discretion so to strike the answer"

(which answers were filed by plaintiffs below without leave of Court, many weeks after they were due and after hearing upon the motion for summary judgment was had).

Judicial discretion is that authority which must be exercised to properly and duly conduct trials and other Court proceedings. Such discretion must not be arbitrary or exhibit perversity of will but should be prudent, circumspect and guided by law.

The trial Court was guided by the Federal Rules of Civil Procedure. Rule 36 states the requirements; plaintiffs below did not fulfill these requirements. The answers

were not filed within the required time, they were not filed within a "further time as the Court may allow on motion and notice." A trial Court does not abuse its discretion by adhering to the rules as provided by the Supreme Court of the United States.

Conclusion.

Litigants as well as counsel should be able to avail themselves of the provisions of the Federal Rules of Civil Procedure, to the end that litigation be brought to a speedy conclusion. Conflicting interpretations have been placed upon certain rules. The Supreme Court of the United States, having fostered and adopted the rules, has the supervisory capacity and duty to enforce and interpret the rules.

It is respectfully urged that procedure will be expedited and rendered uniform by deciding the question presented in the instant case. The facts and the law require a reversal of the judgment of the Circuit Court of Appeals.

Respectfully submitted,

CASIMIR A. MIKETTA,

Attorney for Petitioners.

Service of the within and receipt of a copy thereof is hereby admitted this.....day of August, A. D. 1945.

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vs.

F. H. BOWERS and LOUIS J. BRISTOW,

Respondents.

Respondents' Answer to Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit, and Brief in Support Thereof.

To the Honorable, the Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Come now the respondents, F. H. Bowers and Louis J. Bristow, answering the petition of Robert A. Fischer, The Fischer Corporation and A. S. Aloe Company for a writ of certiorari to review the judgment of the United States Circuit Court of Appeals for the Ninth Circuit, and pray for an order of this Court denying said petition.

Jurisdiction.

The Circuit Court of Appeals, herein, has decided not only a question of practice and procedure, but, also, a question involving the taking of valuable property rights of respondents without due process of law and in violation of the rules of procedure prescribed by this Court, F. R. P. C. 5(b), 52(a) and 56(c), and in violation of Section 723C of the Judicial Code and the Seventh Amendment to the Constitution of the United States.

There have been concurrent findings in this Court and in the courts below:

Refractolite Corporation v. Prismo Holding Co., 25 Fed. Supp. 965 (N. Y., 1938);

Clair v. Sears, Roebuck & Co., 34 Fed. Supp 559;

Weil v. N. J. Richman Co., Inc., 34 Fed. Supp. 401;

Frank v. Western Electric Co. (2d Cir.), 24 F. (2d) 642;

New York Belting Co. v. New Jersey Rubber Co., 137 U. S. 445, 11 S. Ct. 193, 34 L. Ed. 741.

Short Statement of the Case.

The complaint of respondents was filed in the United State District Court, Southern District of California, Central Division, at Los Angeles, California, on October 26th, 1942. [Clk. Tr. p. 9.]

F. H. Bowers was the only attorney of record for the respondents until April 12th, 1943. [Clk. Tr. p. 114.]

On December 4th, 1942, petitioners knew that Bowers resided and had his professional offices at Roseville, California, and on December 7th, 1942, through correspondence by mail obtained from Bowers a stipulation extend-

ing the time for petitioner to answer respondents' complaint. [Clk. Tr. pp. 97-98.] Roseville, California, is more than 425 miles from Los Angeles, California.

Notwithstanding the fact that petitioners knew the address of F. H. Bowers to be at Roseville, California, they mailed all notices and requests upon which they rely in this action to said Bowers at 2861 West Pico Boulevard, Los Angeles, California, which was not the *last known address* of said Bowers. (Rule 5b requires service upon the *last known* address.)

The net result of the misdirection of said mail on the part of the petitioners was that none of the notices or requests were delivered to respondents' said attorney until about the 19th day of April, 1943 [Clk. Tr. pp. 95-96], when he appeared in court at Los Angeles to resist petitioner's notice of motion for summary judgment. [Clk. Tr. p. 79.]

That within four days of the receipt of petitioners' requests for admissions, by said Attorney Bowers, the respondents filed their answer to each specific request on the 23rd of April, 1943 [Clk. Tr. pp. 53-62]; but the trial court refused to consider said answers and struck them from the record and ordered the preparation of summary judgment for the petitioner [Clk. Tr. pp. 109-110], and subsequently without any evidence, adjudged that the patent entitled "Therapeutic Light Ray Apparatus and each and every of the claims thereof, is invalid, null and void." [Clk. Tr. pp. 111-112.] No order of default was made before the answers were filed by Bowers—three weeks before the motion for summary judgment was granted.

The Judgment.

The complaint of the respondents and the answer of the petitioner placed in issue (1) the ownership and title of the patent in respondents; (2) the validity of the patent in relation to the specification of its claims; (3) whether the patentees had made a proper disclaimer of the claims alleged to be infringed; (4) whether the patent was for an apparatus whose elements and their combination were a matter of common knowledge in the art; (5) whether the apparatus had been patented in prior patents.

Obviously, each of the foregoing issues are issues of fact. Each is a material issue of fact, which must be disposed of by evidence submitted on each by witnesses competent to testify as to the fact in issue and by competent documentary evidence, not upon affidavits of parties and their attorneys that a patent is or is not void.

Furthermore, under Rule 52(a) of the Federal Rules of Civil Procedure the trial court *must make special findings of fact* on each material issue, and *must state separately its conclusions of law thereon*, and direct the entry of the appropriate judgment.

The requests for admissions submitted by petitioners, and the answers thereto submitted by the respondents, further evidence the extent and nature of these material issues, which should have been heard and determined by the trial court in accordance with Rule 52(a) before a valid judgment could be entered.

Rule 56(c) of the Federal Rules of Civil Procedure, upon which petitioner relies, provides:

> "The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, *show that,* except as to the amount of damages, *there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.*" (Italics ours.)

The state of the record in this case, even after the respondents' answers to petitioners' requests for admissions had been erroneously stricken by the trial court, was such that genuine issues of material facts remained undetermined, and the moving party was not entitled to a judgment as a matter of law.

Weil v. N. J. Richman Co., Inc., 34 Fed. Supp. 401 at p. 402;

Frank v. Western Electric Co., 24 F. (2d) 642;

New York Belting Co. v. New Jersey Rubber Co., 137 U. S. 445, 11 S. Ct. 193, 34 L. Ed. 741.

On an appeal from a summary judgment, the appellant is given the benefit of every doubt.

Weisser v. Mursom Shoe Corp., 127 F. (2d) 344.

A patent case in which both validity and infringement of the patent are in issue may not properly be disposed of upon motion for summary judgment (*Refractolite Corp. v. Prismo Holding Corp.,* 25 Fed. Supp 965; *Clair v. Sears, Roebuck & Co.,* 34 Fed. Supp 559), and particularly not upon affidavits setting forth the opinion of the plaintiff and his attorney as to the validity of the patents.

Conclusion.

The rules of the Supreme Court were revised and drafted with the intent and purpose of effecting an orderly procedure in the interests of justice. They were not intended as a substitute for the right of a trial on the merits nor to reward by a default judgment parties who seek to gain advantages by knowingly breaching the rules as to service.

The record in this case discloses that the petitioners, in disregard of the rules, misdirected their requests for admissions, by mail, to an address some 425 miles away from the "last known" office and residence of respondents' attorney, who was charged with the responsibility of answering the requests for admissions within a specified time, with the result that the attorney did not receive these documents until after the petitioners had filed their notice of motion for a summary judgment, based upon respondents' failure to answer the requests for admissions. They now seek to take advantage of their own disregard of the rules.

The respondents filed answers to the requests for admissions within four days after their attorney had received them. The trial court erroneously struck these answers filed by respondents from the files, and then ordered a summary judgment, and in its order stated that *"there is no genuine issue as to any material fact,"* and then in the following paragraph adjudged and decreed that the patent in suit, entitled *"Therapeutic Light Ray Apparatus and each and every of the claims thereof, is invalid, null and void."*

We respectfully submit that the judgment of the Ninth Circuit Court of Appeals, reversing the judgment of the trial court and giving respondents their day in court is proper, and that the petition of Robert A. Fischer, The Fischer Corporation and A. S. Aloe Company for a writ of certiorari herein should be denied. This is a court of justice not a court of technicalities!

F. H. BOWERS,
Attorney for Respondents.